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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/715,056  
Filing Date: November 17, 2003  
Appellant(s): JONES, DONALD R.

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Dane C. Butzer  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed June 24, 2008 appealing from the Office action mailed August 6, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

4,741,537	Adam	5-1988
5,647,805	Tarbox, Jr.	7-1997
5,529,307	Chang	6-1996
2003/0162598	Eckardt, Jr. et al.	8-2003
4,779,796	Lai	10-1988
3,693,979	Koett	9-1972

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adam (U.S. Patent No. 4,741,537) in view of Tarbox, Jr. (U.S. Patent No. 5,647,805).

**Claims 1 & 15:** Adam generally discloses a golf-teeing device having a golf ball storage and feeding means in combination with a tee-lifting means which are selectively actuatable for smoothly and efficiently placing golf balls upon a tee at a desired height without the need for adjustment of the golfers stance or handgrip. Adam discloses the invention substantially as claimed, including an automatic tee-up device with a golf ball reservoir (figure 1[8]) and a platform (figure 1[25]) with a groove (figure 1[54]) for a golf ball to travel from the reservoir to a tee, where the tee is movable

from below a level of the golf ball in the groove to above the level of the golf ball in the groove (figures 1, 5, 8, & 9, column 2, lines 20-65, and column 3, line 34 – column 7, line 6). Adam also discloses a ball ejector (figure 1[37]) disposed to eject golf balls one at a time from the reservoir onto the groove (figures 1, 5, 8, & 9, and column 6, lines 25-41), wherein after the golf ball is ejected by the ejector, the golf ball travels on the groove to the tee and is raised by the tee into a position suitable for striking with a golf club (column 3, line 34 – column 7, line 6). Adam also discloses a lever (figure 1[7]) that projects from the platform and that actuates the ball ejector and the tee via a head of a golf club (figures 1, 3, & 6 and column 3, lines 40-44). Regarding claim 15, the method limitations coincide with the structural limitations of the device disclosed above and can be seen ascertainable via the disclosure above.

Adam explicitly lacks disclosing and/or teaching the lever projecting from the platform is specifically actuated on a horizontal plane in a horizontal arc. Regardless of this deficiency, it would have been extremely obvious for the designer of Adam's system to try various actuation systems when finally coming to the conclusion that the pedal actuation system appeared to work best, nevertheless, Tarbox, Jr. explicitly teaches and discloses a lever in an automatic teeing device that actuates the process of moving a ball from the reservoir to the tee based on the end of the lever moving in a horizontal arc (see at least figures 1 & 2, where figure 2 shows the explicit movement of the lever from a first position represented by solid lines and a second position represented by the dotted lines, and movement from the first position to the second position occurs by moving an end of the lever in a horizontal arc at least when viewing the invention from a top-view perspective similarly to as Adam is viewed to have a lever that is depressed in the vertical direction). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Adam's lever/pedal actuation system such that the lever/pedal was to be

moved in a horizontal arc as taught by Tarbox, Jr. at least for the reason that various actuation systems are interchangeable to those of ordinary skill in the art, and because such a modification to Adam via the teaching of Tarbox, Jr. would have only required routine skill in the art.

Alternatively, as a side note, without need of the secondary reference, the Examiner respectfully submits that modifying the actuation system from the vertical plane to the horizontal plane does not appear to be patentability distinct and would have been obvious to try as common sense to one of ordinary skill in the art since that person of ordinary skill in the art has good reason to pursue known options within his or her technical grasp (i.e. “Do I want a system where the golf presses a button or do I want a system where a golfer actuates a lever?”, such in a pinball machine where a player pulls on a lever in the horizontal direction to eject a ball, thus, it is submitted that such mechanical options to the designer are well known in the art), which may lead to anticipated or predictable success, thus, such modifications are not likely to be the product of innovation but rather of ordinary skill and common sense.

**Claim 2:** Adam discloses the platform includes a mat that has a groove (figures 1 & 3).

**Claim 3:** Adam discloses the mat with the groove is removable from the rest of the platform (figure 3).

**Claim 4:** Adam discloses the platform includes at least one other mat (figure 1[2]) positioned where a golfer stands on the platform (figure 1 and column 3, lines 36-37).

Claims 5 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adam & Tarbox, Jr., as applied to claims 1-4 & 15, where applicable, further in view of Chang (U.S. Patent No. 5,529,307).

**Claims 5 & 16:** The combination of Adam & Tarbox, Jr. discloses the invention substantially as claimed except for explicitly disclosing an agitating block within the golf ball reservoir so as to

allow golf balls to eject one at a time, where the golf balls are agitated within the reservoir. However, Chang discloses an analogous automatic golf ball teeing device in which an agitator is explicitly disclosed to be disposed within the bin or reservoir of balls so as to simulate some movement to prevent the balls from clogging or jamming within the bin or reservoir (Chang, column 3, lines 5-11, where either the plate or arm may be considered the "agitator block" in the two agitator embodiments disclosed). Motivation lies within the definition, the agitator agitates the balls to prevent clogging or jamming, thus, one of ordinary skill would have found it obvious to modify the combination of Adam & Tarbox, Jr. for at least the same reason to avoid any jamming or clogging of the balls within the reservoir that fall down the tubes of the device, one at a time. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Adam & Tarbox, Jr. with the teaching of Chang at least for the purpose of preventing jams in the automatic tee-up device.

Claims 8-10, 18, & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adam & Tarbox, Jr., as applied to claims 1-4 & 15, where applicable, further in view of Eckardt, Jr. (U.S. Patent Application Publication No. 2003/0162598).

**Claims 8, 9, & 18:** The combination of Adam & Tarbox, Jr. discloses the invention substantially as claimed including, regarding claim 9, the tee is removable so as to facilitate replacement of the tee. The tee is removable because it may be glued in place and the height of the tee may be increased or decreased by increasing or decreasing the number of spacers (Adam, figure 7[91]). However, Adam appears to lack explicitly disclosing the lever is connected to a ramp and the tee is connected to a tapered block (extension 62) that rests on the ramp such that movement of the ramp causes the tee to raise or to lower. Eckardt, Jr. explicitly discloses the lever is connected to a

ramp and the tee is connected to a tapered block that rests on the ramp such that movement of the ramp causes the tee to raise or lower (Eckardt, Jr., figures 2 & 7, and paragraphs 0012, 0018, 0020-0024, 0057, 0072-0076, 0096, 0097, & 0106). It would have been obvious at the time of Applicant's invention to modify the lever of the combination of Adam & Tarbox, Jr. with that of Eckardt. One would be motivated to do such that a golfer is then able to practice with different clubs at various tee heights, such as when driving it we beneficial to the golfer to have the tee up higher than say that for a nine iron or a putter.

**Claims 10 & 19:** The combination of Adam & Tarbox, Jr. discloses the invention substantially as claimed including different positions of the lever corresponding to different tee heights (figures 2 & 7 and paragraphs 0012, 0018, 0020-0024, 0057, 0072-0076, 0096, 0097 & 0106). The combination appears to explicitly lack disclosing a scale adjacent the lever corresponding to the tee heights. Regardless of the deficiency it would have been an obvious matter of routine skill in the art to add a scale or some type of numbering system adjacent the lever to correlate the different positions of the lever to different tee heights. Eckardt explicitly discloses a system in which the tee is moveable to a desired height and the explicit advantage of such a system that is able to vary the height of the tee for accommodating a range of golfers with different preferences (paragraph 0101). Thus, it would have been natural for one of ordinary skill, such as the designer of the system, to include a scale or numbering system to correlate the different positions of the lever to a height of the tee in a conventional system (i.e. a number of inches) for at least the reason that a golfer is able to experiment as to figure out what tee height works best and consistently use said tee height each time he returned to use the device without having to go through the process of determining what tee height suits him best. There are a plurality of prior art devices that are notoriously well known in the art the are used by golfers to put tees into the ground at specific



heights, such devices provide motivation to achieve the same effect in an automatic tee-up device where the platform the golfer is able to get the same tee height he may use on the golf course via one of these well known tools to help golfers place their tees at a specific height. Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Adam & Tarbox, Jr. as discussed above.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adam & Tarbox, Jr., as applied to claims 1-4 & 15, where applicable, further in view of Lai (U.S. Patent No. 4,779,796).

**Claim 11:** The combination of Adam & Tarbox, Jr. discloses the invention substantially as claimed except for explicitly disclosing one or more leveler feet on which the platform rests, the leveler feet permitting the platform to be leveled. However, Lai, an analogous golf teeing device, teaches one or more leveler feet (wedge leaf 13) on which the platform rests, the leveler feet permitting the platform to be leveled (figures 1 & 10 and column 2, lines 6-12). Although the wedge leafs are typically used to simulate a sloping surface on a golf course, they may also be used to level the golf platform on an un-level surface. Lai provides motivation for such a modification by teaching a height adjustable golf platform, thus, such features were known and would have been easily combinable or implemented into other known golf teeing systems such as that disclosed by the combination of Adam and Tarbox, Jr. Therefore, such a modification would have been prima facie obvious to one of ordinary skill in the art at the time of the invention.

**Claim 12:** Lai also discloses the platform folds along a hinge and may be locked such that the device may be stored away when not in use, thus, the combination of Adam, Tarbox, Jr., & Lai disclose the platform further includes at least one hinge by which the platform can be folded up.

**Claim 13:** The combination of Adam & Tarbox, Jr. discloses the groove is in a removable mat on the platform and the platform includes at least two mats positioned where a golfer stands on the platform (figures 1, 5, 8, & 9, column 2, lines 20-65, and column 3, line 34 – column 7, line 6). However, the combination appears to lack in explicitly disclosing a seam between the two mats aligns with the hinge. Lai teaches such a seam (figures 6 & 13-15). It would have been obvious to align the seam with the hinge as is done in many industries when it comes to foldable/portable devices for the simple reason of aesthetics, to be user-friendly (i.e. a user is able to locate where it folds, quickly), and cost effectiveness. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Adam & Tarbox, Jr. for at least the reasons given above.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adam, Tarbox, Jr., & Lai, as applied to claims 11-13, where applicable, further in view of Koett (U.S. Patent No. 3,693,979).

**Claim 14:** The combination of Adam, Tarbox, Jr., & Lai disclose the invention substantially as claimed except for explicitly disclosing at least two wheels disposed for moving the automatic tee-up device when the platform is folded up. However, Koett, an analogous golf practice device, teaches roller means (78) supporting the device such that the device may be moved to any desired location, thus, Koett teaches at least two wheels disposed for moving an automatic tee-up device when the platform is folded up. It would have been obvious at the time of Applicant's invention to modify the combination of Adam, Tarbox, Jr., & Lai with the roller means of Koett in order to roll the golf teeing device to any desired location or to be stored away when not in use.

**(10) Response to Argument**

The Applicant argues four specific limitations with respect to claims 1, 5, 8, 9, 15, 16, 18, & 19.

Regarding claims 1 & 15, the Applicant argues that neither Adam nor Tarbox, Jr. disclose "the ball ejector and the tee are actuated by moving an end of the lever in a horizontal arc" (pages 7-11). However, the language is of insufficient specificity. The Applicant supports the argument by indicating that Tarbox, Jr. "definitely does not explicitly teach and disclose a lever in an automating teeing device that actuates the process of moving a ball from the reservoir to the tee based on the end of the lever moving in a horizontal arc" as submitted by the Examiner. The Examiner respectfully disagrees and submits that movement in any direction other than exactly vertical (90 degrees) or exact horizontal (180 degrees), will have some component of movement in both the vertical and horizontal plane. Tarbox, Jr. does not disclose exactly vertical movement of an equivalent lever for such arguments to be valid. The Applicant further submits that the Examiner is using a side-view (figures 1 & 2) of the Tarbox, Jr. invention and such depiction clearly does not illustrate movement of the lever in a horizontal arc. The Examiner agrees that figures 1 & 2 of Tarbox, Jr. are a side-view of the invention, however, disagrees that it does not clearly convey to those skilled in the art that there is a horizontal component of movement to the lever 6.

As shown in figure 2, Tarbox, Jr. explicitly teaches a lever 6, when moved from a first position illustrated by solid lines to a second position illustrated by dotted lines (the movement also illustrated by a dotted line), actuates the process of moving a ball from the reservoir to the tee. The lever 6 clearly has a horizontal component to its motion. The Examiner directs attention to figure 7, which shows a top-view of the Tarbox, Jr. invention. Imagine you are standing in front of the device, gazing from the tee to the reservoir. To actuate the lever, you will "push" the lever such

that the lever will move further away from you, back into the device, and eventually stop against the reservoir as illustrated in figure 3 (via a side-view). The pushing action clearly moves the lever in a horizontal arc. Granted, the lever is vertically attached, the movement of the lever still remains to be in a horizontal plane as seen from the top-view (i.e. there is no exact and only vertical movement of the lever). It appears the claimed limitation is of insufficient specificity, thus, multiple interpretations appear applicable, such as this one taken by the Examiner. The Applicant also argues the Examiner's alternative KSR-type rationale is inadequate, however, the rejection does supply an "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" within the rejection as reproduced above. For at least these reasons, the Examiner submits the rejection of at least claims 1 & 15 set forth in the Office Action mailed August 6, 2007 is proper.

Regarding claims 5 & 16, the Applicant argues that Chang does not disclose or suggest an agitator that "operates in conjunction with an agitating block within the golf ball reservoir so as to eject the golf balls one at a time". The Examiner respectfully disagrees. Chang explicitly discloses an agitator is disposed within a bin (i.e. a reservoir for the golf balls) to simulate movement of the balls to prevent the balls from clogging in the bin during operation. One such agitator uses an "arm" located near the bottom of the bin that slowly spins during operation (column 3, lines 5-11). The Applicant's claimed "agitator block" is not clearly defined, that is, a "block" may merely refer to an assembly of components (i.e. an engine block). The Applicant's claimed limitation is sufficiently broad enough to encompass the mechanical arm disclosed by Chang. Specifically, the "arm" disclosed by Chang is considered to be equivalent to applicant's claimed "agitator block", as it does not appear to be sufficiently defined as an actual "block" or "cube" shaped mechanical component or any specific details other than the agitator block is used to agitate golf balls so as to

ject the golf balls one at a time from the reservoir, which Chang clearly teaches. For at least these reasons, the Examiner submits the rejection of at least claims 5 & 16 set forth in the Office Action mailed August 6, 2007 is proper.

Regarding claims 8 & 18, the Applicant argues that Eckardt, Jr. et al. does not teach a lever connected to a ramp and the tee being connected to a tapered block that rests on the ramp, such that the movement of the ramp causes the tee to raise or to lower. The Applicant supports the argument by indicating paragraphs 0024 and 0097 of Eckardt, Jr. et al. disclose the "ramp" is a stopping member, such that the ramp does not cause the tee to raise or lower, but rather limits upward movement of tee. The Examiner respectfully disagrees. Again, the Examiner submits the language of the instant claims is of insufficient specificity. In a reasonable interpretation, Eckardt, Jr. et al. disclose figure 7, that shows an elevation mirror image of the first half of the mechanism of figure 5 taken from the side at the lowermost part of the drawing, which is essentially a side-view of the golf ball teeing invention disclosed by Eckardt, Jr. et al. As seen, there are a plethora of mechanical components interconnected either directly or indirectly to one another to form the golf ball teeing device. Thus, in the broadest reasonable interpretation, the Examiner submits that Eckardt, Jr. et al. disclose the lever (lever 7) is connected to a ramp (ramp 64) and the tee is connected to a "tapered block" (extension 62) that rests on the ramp (i.e. paragraph 0074 discloses the extension 62 abuts ramp 64, which equivalent to "rests on") such that the movement of the ramp (i.e. the entire internal mechanism causes movement of the ramp) causes the tee to raise or to lower (paragraph 0024, discloses a stopping member may comprise a ramp, where the ramp may be arranged to adjust the height of the tee, that is, to raise or lower the tee). Thus, the disclosure appears to disclose a ramp, a tapered block, and the movement of the tee to raise or lower. The Applicant appears to argue that the arrangement of these components is not commensurate with

the claimed arrangement, however, the claimed arrangement merely requires that the components are connected to one another, which Eckardt, Jr. et al. appear to clearly convey in figure 7. Each of the components are connected to one another, either directly or indirectly, wherein movement of the entire internal mechanism causes the tee to be raised or lowered, including movement of the ramp and tapered block. Thus, in view of Eckardt, Jr. et al. disclosing each of the components and a means for these components to be connected, it is respectfully submitted the claimed limitation is met. For at least these reasons, the Examiner submits the rejection of at least claims 8 & 18 set forth in the Office Action mailed August 6, 2007 is proper.

Regarding claims 10 & 19, the Examiner brings attention to the Applicant's argument, in which the Applicant reproduces a portion of the Examiner's rejection for use in convey his argument. However, it should be noted the section reproduced by the Applicant is not the discussion of claims 10 & 19 as recited in the Office Action of August 6, 2007. Then, the Applicant proceeds to argue that there is no teaching of a scale. The Examiner partially agrees, however, if the Applicant had reviewed the correct portion of the action in detail, it would be apparent that a scale explicitly is obvious in view of known teachings in the art. The combination of Adam & Tarbox, Jr. did not disclose a scale. Eckardt Jr., et al., however, explicitly discloses a system in which the tee is moveable to a desired height and explicitly discloses the advantage of such a system is to vary the height of the tee for accommodating a range of different golfers with different preferences (paragraph 0101). Further, as noted in the rejection, there are known prior art devices that are notoriously well known to those skilled in the art to put tees into the ground at specified heights (i.e. using a scale or ruler-type feature), thus, such devices appear to provide support and motivation for those skilled in the art to modify the combination of Adam, Tarbox, Jr. and Eckardt, Jr. et al. to provide a scale adjacent the lever. The combination of the prior art and

common knowledge (i.e. known devices in the art) would have provided those skilled in the art with sufficient motivation to provide a specific scale adjacent the lever, as described in detail in the Examiner's rejection of claims 10 & 19.

For at least these reasons, the Examiner submits the rejection of at least claims 10 & 19 set forth in the Office Action mailed August 6, 2007 is proper.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Milap Shah/

Examiner, Art Unit 3714

Conferees:

/John M Hotaling II/

Primary Examiner, Art Unit 3714